

REMARKS

The Applicants request reconsideration of the rejection.

Claims 1-8 are pending.

The Form PTO-1449 filed with the Information Disclosure Statement on December 4, 2001 has been initialed and returned with the Office Action (Paper No. 5). However, references AN (JP 3-10919) and AR (A Full System Decontamination of the Oskarshamn 1 BWR) have been crossed out. The Applicants respectfully request the Examiner to indicate consideration of these documents, which formed part of the art of record in the parent application. A copy of the Form PTO-1449, and a copy of each of these references, are enclosed for the Examiner's convenience.

Claims 1-8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Murray et al U.S. Patent No. 4,729,855 (Murray) in view of Milner U.S. Patent No. 5,523,513 (Milner) and Mochizuki et al JP 409174066 (Mochizuki).

The primary reference to Murray discloses a method of removing radioactivity from a surface, including a decontamination step in which oxalic acid and hydrazine are added to remove radioactive deposits from the surface. Murray also teaches that the decontaminating agent is supplied to a cation exchange resin column to remove metal ions chelated

during the decontamination step. However, as noted by the Examiner, Murray fails to teach that the injection of hydrazine should be stopped after the cation resin breaks. The Examiner finds that one of ordinary skill in the art would obviously stop the injection of hydrazine after the cation resin breaks "because the cation resin would no longer be useful and would be obvious to replace with a new cation resin."

Respectfully, the Applicants submit that the failure of Murray to teach any response to the breaking of the cation resin indicates a lack of recognition that the breaking of the cation resin is a significant development. Note that Murray does not teach to add, subtract, or modify the injection of hydrazine before the cation resin breaks, when the cation resin breaks, or after the cation resin breaks. On the other hand, the present inventors have found that the hydrazine itself can cause corrosion of the metallic material of the treated surface, such that continuing the injection of hydrazine after the cation resin breaks results in avoidable corrosion which can be prevented by stopping the injection of hydrazine. Murray does not teach when the injection of hydrazine should stop, providing only the positive teaching of the addition of the hydrazine for the stated purpose. In

other words, there is no suggestion to the person of ordinary skill that hydrazine injection after breaking of the cation resin is a negative development.

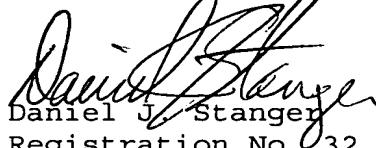
In addition, neither of the secondary references to Milner or Mochizuki suggests the stoppage of the hydrazine injection. Accordingly, the combination of Milner and Mochizuki with Murray does not render the claims obvious.

Claims 1-8 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,335,475. A Terminal Disclaimer accompanies this Reply to avoid the double patenting rejection, without admitting to its propriety.

However, the Applicants do note that the stated grounds for the rejection (the claims "are not patentably distinct from each other because they overlap in scope of subject matter claimed") is insufficient to support a double patenting rejection, since mere overlap of claimed subject matter does not support a *prima facie* case of obviousness.

In view of the foregoing amendments and remarks, the Applicants request reconsideration of the rejection and allowance of the claims.

Respectfully submitted,

  
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